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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,501	07/20/2001	Steven C. Johnson	10003562-1	4153

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ARTHUR JEANGLAUDE, GERTRUDE

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,501

Applicant(s)

JOHNSON ET AL.

Examiner

Gertrude Arthur-Jeanglaude

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 72001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1, 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "to provide send and receive capabilities with an electronic service site" is unclear.

In claim 5, the phrase "**to provide send and receive capabilities** between the computer peripheral device and an external electronic service site" is unclear.

Claim 14 recites the limitation "the CPU" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danknick et al. (US 5,901,286) in view of Moshaiov (US 6,678,726).

As best understood by examiner, regarding claim 1, Danknick et al. disclose as shown in Fig. 1 an electronic service transaction apparatus comprising a computer peripheral device (1,3) having a communication link (6) to provide send and receive capabilities with an electronic service site ((20) via (4,8) wherein the communication link (6) is operative to connect the computer peripheral device with the electronic service site through the internet. Danknick et al. discloses sending an e-mail message to a workstation (See col. 13, lines 65-67). However, Danknick et al. fail to specifically disclose a messaging system and the messaging system is accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with the electronic service site. In an analogous art, Moshaiov discloses a method and apparatus for automatically determining topology information for a computer within a message queuing network and has the capability to be accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with an electronic service site (See abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the electronic service transaction apparatus of Danknick et al. with the messaging system of Moshaiov in order to detect new message queuing system topology.

As to claim 2, Danknick et al. disclose an embedded web server operative to forward a request for an electronic service to the electronic service site from the computer peripheral device wherein one of ordinary skill in the art would consider using a messaging system.

As to claim 3, Danknick et al. disclose the computer peripheral device as discussed but fail to specifically disclose a messaging system that enables initiation of an electronic service transaction from an electronic service site. In an analogous art, Moshaiov discloses a method and apparatus for automatically determining topology information for a computer within a message queuing network and has the capability to be accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with an electronic service site (See abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the electronic service transaction apparatus of Danknick et al. with the messaging system of Moshaiov in order to detect new message queuing system topology.

As to claims 4-5, Danknick et al. the communication link as discussed but fails to specifically disclose the communication link provided by a mail client of the computer peripheral device that enables a user to submit an e-mail order using a mail program from the computer peripheral device to an external provider of electronic services. In an analogous art, Moshaiov discloses a method and system is provided for a message queuing computer to automatically determine system topology information wherein it discloses the capability to submit an e-mail order obviously using a mail program (See col. 1, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Danknick et al. with that of Moshaiov to enable a user to submit an e-mail order using a mail program from the computer

peripheral device to an external provider of electronic services in order to send and receive information/messages.

As to claim 6, Danknick et al. disclose a dedicated internet connection via world wide web (6) as shown in Fig. 1. but does not specifically disclose a messaging system. In an analogous art, Moshaiov discloses a method and apparatus for automatically determining topology information for a computer within a message queuing network and has the capability to be accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with an electronic service site (See abstract; paragraph 0034). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the electronic service transaction apparatus of Danknick et al. with the messaging system of Moshaiov in order to detect new message queuing system topology.

As to claim 7, Danknick et al. disclose a computer peripheral device as discussed connects with an external server via the Internet (6) as shown in Fig.1 , the computer peripheral device accesses a document on the external server to render a web page, and the electronic service transaction comprises sending a URL for the document to the electronic service, and receiving a print stream from the external server for the document (See Fig. 1, 5; abstract).

As to claim 8, Danknick et al. disclose the computer peripheral device automatically generates a consumable order message in response to the computer peripheral device detecting a need to replenish a consumable and further forwards a

notification to a consumable order web site on an external web server indicating a need to replenish the consumable (See abstract).

As to claim 9, Danknick et al. disclose a computer peripheral device that comprises a printer(10, 17) connected with the Internet via the communication link, wherein a user accesses a document on the Internet via the printer and prints the document using the printer (See col. 3, lines 63-67-col. 4, lines 1-10).

As to claim 16, Danknick et al. disclose a computer peripheral device that comprises an embedded web server (6) as shown in Fig. 1. Danknick et al. fail to specifically disclose the electronic service site comprises a site web server and the communication link comprises an Internet messaging system extending between the computer peripheral device and the site server. In an analogous art, Moshaiov discloses a method and apparatus for automatically determining topology information for a computer within a message queuing network and has the capability to be accessed directly by the computer peripheral device to initiate an electronic service transaction from the computer peripheral device with an electronic service site (See abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the electronic service transaction apparatus of Danknick et al. with the messaging system of Moshaiov in order to detect new message queuing system topology.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Danknick et al. (US 5,901,286) in view of Christensen (US 5,862,431).

As to claim 19, Danknick et al. disclose all but fail to specifically disclose detecting a need for an electronic services transaction comprises detecting a need to order toner. In an analogous art, Christensen discloses a toner detecting system with a toner sensing element that can be used obviously to detect a need to order toner (See abstract; col. 5, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Danknick et al. with that of Christensen by having a toner detecting system in order to detect the toner level condition and to obviously order more supplies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-15, 17-18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Danknick et al. (US 5,901,286).

As to claim 10, Danknick et al. disclose a computer peripheral device comprising an output engine (82) as shown in Fig. 5; a transaction execution subsystem (74) communicating with the output engine; a communication interface (80) communicating with the transaction execution subsystem; and processing circuitry (81) communicating with the transaction execution subsystem and operative to initiate an electronic services

transaction from the transaction execution subsystem using the communication interface via an external network with an electronic services provider (See Figs. 1, 5).

As to claim 11, Danknick et al. disclose the output engine (82; Fig.5) comprises a print engine communicating with the transaction execution subsystem.

As to claim 12, Danknick et al. disclose the communication interface comprises a user interface (90, 91) as shown in Fig.5. of a computer peripheral device.

As to claim 13, Danknick et al. disclose the transaction execution subsystem (74) as shown in Fig. 5 comprises an embedded web server.

As to claim 14, Danknick et al. disclose the CPU (81) as shown in Fig. 5 is further operative to carry out an e-services transaction using the transaction execution subsystem of the computer peripheral device.

As to claim 15, Danknick et al. disclose a method of initiating an electronic services transaction, comprising providing a computer peripheral device as shown in Fig. 1 having a communication link with an electronic service site and an interface system for initiating an electronic service transaction between the computer peripheral device and the electronic service site; detecting a need to initiate an electronic service transaction from the computer peripheral device with an external electronic service site; and initiating an electronic service transaction in response to the detected need using the computer peripheral device (See abstract; Fig. 1, Fig.5).

As to claim 17, Danknick et al. disclose detecting a need for an electronic services transaction comprises receiving a user input (90, 91) as shown in Fig.5 at a user interface of a computer peripheral device that initiates an e-services transaction.

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As to claims 18, 20, Danknick et al. disclose the computer peripheral device comprises a printer (10, 17) wherein the printer completes an electronic services transaction with the electronic service site (See col. 3, lines 63-65).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Webb (US20020143664 A10 discloses a network based gift reminder and purchasing system and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gertrude Arthur-Jeanglaude whose telephone number is (703) 308-7564. The examiner can normally be reached on Monday-Friday from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (703) 308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

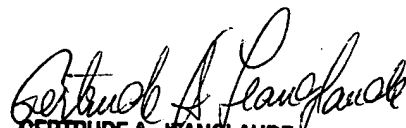
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAJ



October 13, 2004


GERTRUDE A. JEANGLAUDE
PRIMARY EXAMINER